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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
02410335AA	

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Application Number	Filed
10/620,703	7/17/2003

First Named Inventor	
Y. Sakoh	

Art Unit	Examiner
3714	C. Weber

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number **32,635**
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Michael E. Whitham
Typed or printed name

703/787-9400
Telephone number

Aug. 10, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Tradeamrk Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Yoshitaka Sakoh

Serial No. 10/620,703

Filed July 17, 2003

For CONTROLLER

Confirmation No. 9315

Group Art Unit 3714

Examiner Christopher Steven Weber

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is being concurrently filed with a Notice of Appeal. Please charge Deposit Account 50-2041 for the Notice of Appeal. If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for Review, the Commissioner is authorized to charge Attorney's Deposit Account 50-2041 (Whitham, Curtis, Christofferson & Cook, P.C.).

The Invention

The invention solves a specific problem in a specific type of game controller. More particularly, the disclosed and claimed invention eliminates the possibility of damage to the printed circuit board due to the replacement of batteries and operation of push switches. As shown in Figure 1, the main board 1 is provided with a parts holder 2 having a central, table portion 4. Figures 2B and 2C show that the parts holder 2 is attached to the main board 1 by means of positioning pins 21 inserted into holes in the main board and engaging hooks 22, which engage square holes in the main board. Figures 2B and 2C also show that the table portion 4 is elevated above the surface of the main board. Battery terminal holder portions 24, 25 are surrounded by an integrally formed rib 23 formed on the left and right sides of the table portion

4. When the battery terminal board (not shown) is set to the battery terminal holder portions 24, 25, lower end portions of the battery terminal board are projected downward via holes 26 in the bottom plate, as shown in Figure 3B. Push switches 11 provided on the push switch boards 10 are operated by push keys 3. The switch boards 10 are supported by board holder portions 9 which project vertically above the parts holder 2. These holder portions 9 are provided with ribs 29 on the back surface and ribs on the front surface.

Since the battery terminal board is held by the parts holder 2, the back-and-forth movement of the battery terminal board is suppressed by the rib 23 that surrounds the periphery of the battery terminal board. The ribs of the board holder portions 9 withstand the pressure applied by the push keys. In this way, the parts holder 2 isolates the main board 1 from the bending and torsional stresses relating to battery replacement and operation of the push keys, thereby preventing cracking of printed-circuit patterns or damage to soldered portions of the battery contact board.

Errors and Omissions

As to claims 1 and 5–12, the Examiner has failed to demonstrate that the claims are anticipated by U.S. Patent No. 5,685,776 to Stambolic et al., and as to claim 13, the Examiner has failed to make out a *prima facie* case of obviousness under 35 U.S.C. §103 based on the patent to Stambolic et al.

Stambolic et al. disclose an elongated stick-like hand-held game device employing an elongated tubular housing enclosure and unique user controls that take advantage of the device shape and size (col. 1, line 64, to col. 2, line 7, Fig. 1). Figure 3A shows a cross-section of the device. An intermediate housing body 30 is provided with a recessed area 32 for the display 22. The intermediate body 30 provides a battery housing chamber 34 enclosed by a battery housing cover 35 within the body 30. The knob 36 switches the switch 18 based upon a twisting action, and knob 38 provides a pull switch mechanism. Push button ends are provided as push button 40 associated with the knob 36 and a push button 42 associated with knob 38. The knob 36 may be pulled as well as twisted and is supported by a spring 44. A spring 46 is also provided with the knob 38 to facilitate the pull switch function of the knob 38. The knob 36 performs switching of the switch 18 via rotation of the knob 36 which in the hollow interior portions thereof includes a

laterally extending protrusion 48 which at the extremes of rotation of the knob 36 is run into contact with the switch 18 for closure thereof. The knob 38 is provided with wiping contacts 50 interior thereto which make electrical contact at the surface of a printed circuit board (PCB) 52. Thus, as the knob 38 is extended and returned to position, the wiping contact 50 is moved inward and outward along the surface of the PCB 52 to make and break electrical switch contacts thereon. (See col. 4, lines 41–67.) As will be appreciated from the foregoing, Stambolic et al. neither recognize nor provide a solution to the problem solved by the disclosed and claimed invention. Indeed, the Stambolic et al. device is a completely different device in shape, configuration and operation.

In his rejection (see page 3 of the Office Action mailed May, 11, 2007), the Examiner asserts that the recited switch board 10 is to be found in Fig. 5b item 88; however, in the first Office Action mailed August 1, 2006, on page 2, the Examiner admitted that Stambolic et al. does not teach a switch board on which a push switch is mounted and a parts holding member interposed between the switch board and the main board. Reference numeral 88 in Fig. 5b of Stambolic et al. does not refer to a switch board; rather, as stated in col. 6, lines 52–54, a downward force of "the player's hand will depress the push button switch to switch positions 86 and 88" (emphasis added).The Examiner now indicates that the limitation of the parts holder member to be interposed between the switch board and the main board is shown in the diagram on paragraph 7 of the Office Action mailed May 11, 2007, which appears to have been taken from Fig. 5B of Stambolic et al. Similarly, the Examiner indicates that the switch board holding member is shown in the same diagram. However, the left hand arrows of the diagram appear to be pointing to the exterior casing and the depressed position 88 of a push switch. It is not clear what the right hand arrow is pointing to. The Examiner goes on to assert that Stambolic et al. show "a battery terminal integrally or monolithically formed with the parts holding member", citing Figs. 3a & 4b but providing no indication of what elements he has in mind, and "rib-like structure to receive force around both the push switch and battery area", citing Figs. 3a & 5b but providing no indication of what elements he has in mind.

In fact, the Examiner was right in the first Office Action. There is nothing in Stambolic et al. that corresponds to the recited switch board 10 and parts holder member 2 which is interposed between the switch board 10 and the main board 1, as recited in claim 1. Claim 5 is dependent on claim 1 and recites "a battery terminal holding member [24,25], holding a battery terminal and

integrally formed with the parts holding member [2]." Claim 6 is also dependent on claim 1 and recites that "the switch board holding member [9] is monolithically formed with the parts holding member [2]." Claim 7 is dependent on claim 5 and recites that "the battery terminal holding member [24,25] is monolithically formed with the parts holding member [2]." Claim 8 is dependent on claim 1 and recites "a first rib [23] formed on the switch board holding member [9] so as to receive a force generated by an operation of the push switch [11]." Claim 9 is dependent on claim 8 and recites that "the first rib [23] is in contact with the parts holding member [2]." Claim 10 is dependent on claim 8 and recites that "the first rib [23] is formed with the parts holding member [2]." Claim 11 is also dependent on claim 8 and recites "a second rib [23], formed on the battery terminal holding member [24,25] and supporting the battery terminal." Nothing like the structure recited in these claims is shown in Stambolic et al.

In claim 12, the parts holder 2 is recited as "having a table portion [4] provided at the center thereof, said table portion being supported by a rib [23] integrally formed from a surface of the table portion to a main surface of the parts holder". Moreover, in claim 12, the battery terminal holder portions 24, 25 are recited as being "formed on both left and right sides of the table portion [4] and surround by said rib [23]". Nothing like this structure is shown in Stabmolic et al.

It is clear from the foregoing that the Examiner is in error in his rejection under 35 U.S.C. §102.. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described . . .", *Verdegaal Bros. v. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (CAFC 1987). The Examiner has failed to show all the elements recited in the claims are to be found in Stambolic et al.

As to claim 13, this claim is dependent on claim 12, neither of which are made obvious by Stambolic et al. The Examiner asserts that "Stambolic discloses the use of pins to secure the main board it does not explicitly disclose the use of engaging hooks. . ."; however, this is not what is recited in claim 13. Claim 13 recites that "the parts holder [2] is positioned by inserting pins [21] into pin holes in the main board [1], the pin holes being provided to both ends of a bottom surface of the parts holder, and the parts holder is fixed to the main board by engaging hooks [22], which are provided to a rear edge of the bottom surface, with square holes formed in the main board." Clearly, since Stambolic et al. do not disclose any structure equivalent to the recited parts holder, the structure recited in claim 13 cannot be obvious. As set out on page 5 of

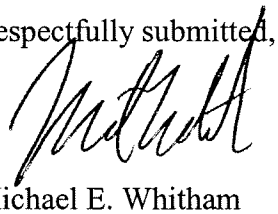
the specification, the inventor has discovered that interposing the parts holding member between a switch board and a main board allows the parts holding member to receive the bending and torsional stresses that would be otherwise applied to the main board during battery changes and when the switch is pushed. Thus, the "functionality of the controller" is improved because there is a lesser likelihood of damage to the main board. The improvements provided by this particular configuration of the claimed controller are significant, unexpected and would not be obvious to one of ordinary skill in the art.

The standard for patentability under 35 U.S.C. §103 was set out by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner has failed to make out a *prima facie* case of obviousness under the *Graham* case.

Conclusion

The Examiner's rejections under 35 U.S.C. §§ 102 and 103 are in error. Stambolic et al. neither anticipates nor makes obvious the claimed invention under the standards of patentability enunciated by the courts. In view of the above, it is requested that the position of the Examiner be reviewed, that the rejections be withdrawn, and that the application be passed to issue.

Respectfully submitted,



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